

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 54

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRAMPTON E. ELLIS III

Appeal No. 2001-1450
Application 08/477,640

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22, 63, 64, 66 through 70, 72, 88, 89, 92 through 94 and 96 through 101, which are all of the claims remaining in this application. Claims 1 through 21, 23 through 62, 65, 71, 73 through 87, 90, 91, 95 and 102 through 111 have been canceled.

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Appellant's invention relates to a shoe sole and, more particularly, to a contoured sole design that conforms to the natural shape of the foot, permitting the foot to react naturally with the ground as it would if the foot were bare, while continuing to protect and cushion the foot, and improving the stability and efficient motion of the shod foot in extreme exercise. Independent claims 22 and 63 are representative of the subject matter on appeal, and a copy of those claims may be found in the Appendix to appellant's brief. It appears that claims 22 and 63, and the claims which depend therefrom, are generally directed to the embodiment of appellant's invention seen in Figure 15 of the application drawings.

The prior art references of record relied upon by the examiner are:

Bretschneider	4,308,671	Jan. 5, 1982
Giese et al. (Giese)	4,366,634	Jan. 4, 1983

Claims 22, 63, 64, 66 through 70, 72, 88, 89, 92 through 94 and 96 through 101 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Bretschneider. According to the examiner (answer, page 4), Bretschneider shows a shoe sole

comprising concavely rounded sole portions through the lowermost portion of the shoe sole as viewed from a frontal plane (Figs. 3 and 4) and as viewed from a sagittal plane (Fig. 7) as claimed.

Claims 22 and 66 through 70 additionally stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Giese. In this instance, in the final rejection (Paper No. 32, page 5), the examiner urges that Giese "shows a shoe sole as claimed inasmuch as the claims are understood." In the answer (page 4), the examiner indicates that Giese "shows a shoe sole with concavely rounded portions as shown in figures 6-10A as claimed."¹

¹As noted on page 2 of the examiner's answer, the rejection of claim 68 under 35 U.S.C. § 112, second paragraph, set forth in the final rejection has now been withdrawn. Further, as noted in Paper No. 53, mailed May 15, 2002, the examiner has also withdrawn the provisional double patenting rejections based on Application Nos. 08/376,661 and 08/162,373 as set forth in the final rejection. According to the examiner, "[d]ue to amendments made in these prior applications and other specific issues in these applications, a proper claim by claim analysis for determining a Double Patenting Rejection cannot be made at this point in time."

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Rather than reiterate the conflicting viewpoints advanced by appellant and the examiner regarding the above-noted rejections, we refer to the final rejection (Paper No. 32, mailed August 17, 1999), the examiner's answer (Paper No. 44, mailed October 6, 2000), to appellant's brief (Paper No. 43, filed September 18, 2000) and the reply brief (Paper No. 45 $\frac{1}{2}$, filed December 6, 2000) for a full exposition thereof.

OPINION

Having carefully reviewed the anticipation issues raised in this appeal in light of the record before us, we have made the determinations which follow.

Before we specifically address the examiner's prior art rejections and appellant's arguments thereagainst, we find it necessary to provide some insights into the terminology used in the claims on appeal. In that regard, we again note that the claims on appeal are generally directed to the embodiment of appellant's invention seen in Figure 15 of the application. As indicated on page 17 of appellant's specification, Figure 15 shows "a fully contoured shoe sole design that follows the

natural contour of all of the foot, the bottom as well as the sides." As further noted, the fully contoured shoe sole assumes that the resulting slightly rounded bottom when unloaded will deform under load and flatten, just as the human foot bottom is slightly rounded unloaded but flattens under load. Thus, the specification notes that the shoe sole material must be of such composition as to allow the natural deformation following that of the foot.

Looking to claims 22 and 63 on appeal, we note that these claims each define a shoe sole for providing the wearer with a stable interaction with the ground, "like the interaction resulting from the curved bottom surface of the wearer's foot sole on the ground." To that end, the claimed shoe sole includes, among other features, "a shoe sole underneath portion [28b] located beneath an intended wearer's foot sole location in the shoe sole, including at least one concavely rounded portion," wherein the concavely rounded portion (as viewed from the perspective of the wearer's foot) has 1) "an inner concavely rounded surface [30] near the intended wearer's foot sole location, as viewed in a frontal plane, when the shoe is upright and not under a bodyweight load," and wherein the concavity

(i.e., degree of concavity) is determined with respect to the intended wearer's foot sole location, and 2) "an outer concavely rounded surface [31], extending through a lowermost portion of the shoe sole as viewed in a frontal plane, when the shoe is upright and not under a bodyweight load," and wherein the concavity is determined with respect to the intended wearer's foot sole location. In addition, the shoe sole includes at least one concavely rounded portion (28a) contoured like the natural form on the side or edge of the human foot and oriented around at least one of the parts of the wearer's foot listed in the penultimate clause of claim 22 and in lines 15-18 of claim 63.

As has been made clear in the present specification, the shoe sole of the invention described therein as being "fully contoured" is comprised of two parts -- a concavely rounded portion (28b) located directly beneath an intended wearer's foot sole location and defined by an inner concavely rounded surface (30b) near the intended wearer's foot sole location and an outer concavely rounded surface (31b) extending through a lowermost portion of the shoe sole as viewed in a frontal plane and from the perspective of the intended wearer's foot, and another concavely rounded surface portion (28a) at each outboard side of

the intended wearer's foot and contoured like the natural form on the side or edge of the human foot (i.e, having an inner concavely rounded surface (30a) near the intended wearer's foot and an outer concavely rounded surface (31a)). The concavely rounded portions are joined together to form the shoe sole (28), with the thickness (s) of the shoe sole (28) being maintained exactly constant so as to provide a naturally contoured shoe sole inside (30) and outside (31) emulating that of the human foot and eliminating any unnatural sharp bottom edge like that seen in Prior Art Figures 2A-2D. On page 10 of the specification, appellant characterizes this aspect of the invention as being "a main feature" of the invention.

With the above as background, we turn to the examiner's rejection of claims 22, 63, 64, 66 through 70, 72, 88, 89, 92 through 94 and 96 through 101 under 35 U.S.C. § 102(b) as being clearly anticipated by Bretschneider. Except for being directed to Figures 3, 4 and 7 of Bretschneider, we are provide with very little guidance from the examiner's rejection as to exactly how the above enumerated claims are to be read on the shoe base or sole structure (2) of that patent. In the final rejection (page 8), the examiner urges that the rounded portion of

Bretschneider's sole "does extend through a lowermost portion, i.e. the side edges of the sole which contact the ground do have rounded portions which are located at the lowermost portion of the sole as shown in figures 2-4, and figures 5-7." However, we share appellant's view (brief, pages 8-9 and reply brief, pages 3-4) that the rounded outer edges of the shoe sole pointed to by the examiner in Bretschneider are not located beneath an intended wearer's foot sole location as required in claims 22 and 63 on appeal, but are clearly located on the side edge of the sole, outboard of and to either side of an intended wearer's foot sole location.

As for the examiner's comment in the answer (page 5) that Bretschneider does show small rounded portions formed by the tread over the entire bottom surface of the shoe sole in Figures 3 and 4, we must agree with appellant's assessment on page 9 of the brief concerning the examiner's position vis-a-vis the tread in Bretschneider. In that regard, we note that the concavely rounded portion forming a part of the shoe sole underneath portion and located beneath an intended wearer's foot sole location as defined in appellant's claims 22 and 63 on appeal is entirely defined by the inner concavely rounded surface and outer

concavely rounded surface which extends through a lowermost portion of the shoe sole as viewed in a frontal plane (Fig. 15), and that no such structure is found in Bretschneider.

In the final analysis, we are of the view that the examiner's broad claim construction set forth on pages 4 and 5 of the answer is in error, and that appellant's assessment of the claimed limitations as reflected in the brief and reply brief is the broadest reasonable interpretation consistent with the specification.

As a result of the foregoing, the examiner's rejection of claims 22, 63, 64, 66 through 70, 72, 88, 89, 92 through 94 and 96 through 101 under 35 U.S.C. § 102(b) as being clearly anticipated by Bretschneider will not be sustained.

The next rejection for our review is that of claims 22 and 66 through 70 under 35 U.S.C. § 102(b) as being anticipated by Giese. As an initial point, we note, as did appellant (brief, page 12), that claims 67 through 70 are dependent from independent claim 63, and claim 63 has not been rejected by the examiner based on the patent to Giese. Thus, the examiner's

rejection of dependent claims 67 through 70 under 35 U.S.C. § 102(b) is somewhat suspect. Moreover, our comments below regarding claims 22 and 66 apply equally well to independent claim 63 on appeal and, thus, to dependent claims 67 through 70.

As for the rejection of claims 22 and 66 based on Giese, we note that the examiner has again provided us with little or no guidance as to how the claims on appeal are to be read on the structure in Giese, and has merely pointed to Figures 6-10A of Giese, urging that this patent shows the concavely rounded portions as claimed. Since we share appellant's view set forth in the brief and reply brief that Giese does not teach a shoe sole like that defined in claims 22 and 66 on appeal, we refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 102(b).

In appellant's shoe sole defined in claims 22 and 66, the concavely rounded portion forming a part of the shoe sole underneath portion and located beneath an intended wearer's foot sole location is entirely defined by the inner concavely rounded surface and outer concavely rounded surface which extends through a lowermost portion of the shoe sole as viewed in a frontal plane

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(Fig. 15); no such sole structure is found in Giese. The portion of the shoe sole in Giese that is located beneath the intended wearer's foot sole location is flat.

In summary: the decision of the examiner to reject claims 22, 63, 64, 66 through 70, 72, 88, 89, 92 through 94 and 96 through 101 under 35 U.S.C. § 102(b) as being clearly anticipated by Bretschneider is not sustained. Likewise, the examiner's decision to reject claims 22 and 66 through 70 under 35 U.S.C. § 102(b) as clearly anticipated by Giese is not sustained.

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Thus, the examiner's decision rejecting the claims before us
on appeal is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JEFFREY V. NASE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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